

REMARKS

Claims 1 – 9 remain in the application. Claims 1, 5, 6 and 9 are amended herein. Claims 10 and 11 are canceled herein. New claims 12 and 13 are added. No new matter has been added.

The Decision on Appeal (Decision), mailed January 4, 2010, in sustaining the rejection of claims 10 and 11 under 35 USC §112 found that “Appellant has not addressed the Examiner’s rejection.” Page 10. Specifically, “Appellant’s arguments directed to enablement do not show that as of the time of filing one skilled in the art would recognize that the Appellant was in possession of the invention.” *Id*, page 11. Thus, the Decision sustained the final rejection of claims 10 and 11.

With regard to the rejection of claims 10 and 11 under 35 USC §103(a), however, the Decision did “not find that the Examiner has demonstrated that the combination of the references teach the features of claims 10 and 11. Accordingly, we will not sustain the Examiner’s rejection of claims 35 U.S.C. § 103(a).” Page 13. Claims 1 and 5 are amended herein to include the recitations of claims 1 and 5 and, therefore, are not taught or suggested by any reference of record.

Further, filed herewith is an affidavit, executed by Reinhard H. Hohensee, showing that “as of the time of filing one skilled in the art would recognize that the Appellant was in possession of the invention” (*supra*) as recited in claims 10 and 11. Specifically, the affidavit states that

When RIP processors 22a – n are added to, or removed from, the controller 10, configuring the controller 10 updates this number *N* and the respective addresses, e.g., the sequencer may be designed to update automatically,

However, updating the Sequencer 21 configuration does not change the Sequencer 21, i.e., it does not require making structural changes to the Sequencer 21;

Page 3. Thus, having addressed the rejection under 35 USC §112, claims 1 and 5, as amended are patentable over all references of record.

Further, the Decision also overturned the final rejection of Claim 9 under 35 USC §101 as being directed to non-statutory subject matter. Therefore, claims 6 and 9, which are amended to include recitations analogous to claims 10 and 11, are patentable over all references of record.

New claims 12 and 13 are added directed to changing the pipeline configuration in response to changing the number of RIP processors, noted in the affidavit with regard to paragraph 0010 of the published application. This is neither shown or suggested by any reference of record. No new matter is added. Independent consideration and allowance of claims 1 – 9, as amended, and new claims 12 and 13, is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner consider claims 1 – 9 and new claims 12 and 13 and allow the application to issue.

As previously noted the MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**. (emphasis added.)

The applicants continue to believe that the written description of the present application

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is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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(Date)

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